



AF/2622  
IFW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Dated: June 22, 2007

PATRICIA S. KRUSE

HP Docket No. 10010789-1

Serial No. : 09/929,430

Examiner M. Milia

Filed : August 13, 2001

Group Art Unit 2622

For : PRESENTATION PRINT JOB PROFILING

Mail Stop Appeal Brief-Patents  
Commissioner for Patents  
P. O. Box 1450  
Alexandria, Virginia 22313-1450

Sir:

**AMENDED SUPPLEMENTAL BRIEF OF APPELLANT**

This Amended Supplemental Brief is presented in opposition to the Examiner's rejection of claims 1-32 in the Office action dated December 12, 2006. Pursuant to the Notification of Non-Compliant Appeal Brief dated May 22, 2007, this Amended Supplemental Brief includes references to page and line numbers of the specification and reference numbers in the drawings, if any, for the subject matter recited in each independent claim. The Amended Supplemental Brief is intended to replace the Brief of Appellants filed March 12, 2007.

**I. REAL PARTY IN INTEREST**

The real party in interest is Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter

"HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holdings, LLC.

## **II. RELATED APPEALS AND INTERFERENCES**

There are no known related appeals or interferences.

## **III. STATUS OF CLAIMS**

The present application was filed on August 13, 2001 with original claims 1-32. In the response dated June 23, 2005, responsive to the Office action dated March 23, 2005, appellant amended claims 1, 3-6, 9, 11-14, 17, 19-22, 25 and 27-30. In the response dated November 21, 2005, responsive to the Final Office action dated September 20, 2005, Appellant made no amendments to the claims. Appellant has reinstated the present appeal without amending the claims in response to the Examiner reopening of prosecution with the Office action dated December 12, 2006.

Claims 1-32, as amended in the response dated June 23, 2005, are the claims at issue in this appeal.

## **IV. STATUS OF AMENDMENTS**

No amendments have been made subsequent to appellant's response dated June 23, 2005.

## **V. SUMMARY OF CLAIMED SUBJECT MATTER**

The summary is set forth in exemplary embodiments. Discussions about elements and recitations of claimed subject matter can be found at least at the cited locations in the specifications and drawings.

The claims of the present application are directed to methods of printing a plurality of files in a presentation package, and computer-readable mediums, computing devices and user interfaces for printing a plurality of files in a presentation package.

Claim 1 is an independent claim directed to a method of printing a presentation package in response to a single print request. With reference to Fig. 9, the method comprises adding a plurality of files to a presentation profile. (pg. 13, ln. 17, ref. # 904). The method further comprises, with respect to each of the files in the presentation profile, specifying individual printing characteristics. (pg. 13, ln. 16-21, ref. #906; pg. 13, ln. 26 – pg. 14, ln. 3, ref. # 914). Further with respect to each file in the presentation profile, the method comprises specifying individual packaging characteristics. (pg. 13, ln. 21-26, ref. #s 908, 910, 912). In addition, the method comprises printing in response to a single print request a presentation package, which includes each file in the presentation profile, based on the individual printing and packaging characteristics corresponding to each file in the presentation profile (pg. 14, ln. 3-4, ref. # 916).

Claim 9 is an independent claim directed to a computer-readable medium comprising computer-executable instructions to print a plurality of files in a presentation. The computer-executable instructions comprise instructions for adding a plurality of files to a presentation profile. (pg. 13, ln. 17, ref. # 904). The instructions further comprise, with respect to each of the files in the presentation profile, specifying individual printing characteristics (pg. 13, ln. 16-21, ref. #906; pg. 13, ln. 26 – pg. 14, ln. 3, ref. # 914). Further with respect to each of the files, the instructions comprise specifying individual packaging characteristics. (pg. 13, ln. 21-26, ref. #s 908, 910, 912).

In addition, the instructions comprise printing in response to a single print request a presentation package, which includes each file in the presentation profile, based on the individual printing and packaging characteristics corresponding to each file in the presentation profile. (pg. 14, ln. 3-4, ref. # 916).

With reference to Figs. 8 and 9, claim 17 is an independent claim directed to a computing device (pg. 11, ln. 10-16, ref.# 802) comprising a memory (pg. 12, ln. 1-8, ref. #814), which comprises computer executable instructions for automatically printing each file in a presentation profile. (pg. 12, ln. 8-12, ref. #818; pg. 12, ln. 24 - pg. 13, ln. 11, ref. # 818). The computing device 802 further comprises a processor (pg. 11, ln. 1-12, ref. #812) operatively coupled to memory (pg. 11, ln. 1-7, ref. #814) and configured to fetch and execute computer executable instructions 818 from memory 814. Computer executable instructions 818 comprise instructions for adding a plurality of files to a presentation profile. (pg. 13, ln. 17, ref. # 904). The instructions further comprise, with respect to each of the files in the presentation profile, specifying individual printing characteristics (pg. 13, ln. 16-21, ref. #906; pg. 13, ln. 26 – pg. 14, ln. 3, ref. # 914) and specifying individual packaging characteristics (pg. 13, ln. 21-26, ref. #s 908, 910, 912). In addition, the instructions comprise printing in response to a single print request a presentation package, which includes each file in the presentation profile, based on the individual printing and packaging characteristics corresponding to each file in the presentation profile. (pg. 14, ln. 3-4, ref. # 916).

Claim 25 is an independent claim directed to a user interface. (pg. 6, ln. 5-17, ref. # 106). User interface 106 comprises a first area for adding a plurality of files to a

presentation profile (pg. 8, ln. 1-11, ref. #400); a second area for specifying a set of individual packaging characteristics with respect to each individual file in the presentation profile (pg. 9, ln. 24 - pg. 10, ln. 6, ref. #s 604, 606, 608); a third area for indicating a set of individual printing characteristics with respect to each individual file in the presentation profile (pg. 10, ln. 11-27, ref. #610); and a fourth area for printing in response to a single print request a presentation package, which includes each file in the presentation profile, based on the individual printing and packaging characteristics corresponding to each file in the presentation profile (pg. 14 ln. 3-4, ref. #204-6).

#### **VI. GROUND OF REJECTION**

In the Office action dated December 12, 2006, claims 1, 4, 6-9, 12, 14, 15-17, 20, 22-25, 28, and 30-32 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,579,087 to Salgado ("Salgado").

Further, claims 2, 10, 18, and 26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Salgado in view of U.S. Patent No. 6,026,416 to Kanerva et al. ("Kanerva et al.").

Moreover, claims 3, 5, 11, 13, 19, 21, 27, and 29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Salgado in view of U.S. Patent No. 5,481,353 to Hicks et al. ("Hicks et al.").

Finally, claims 1-32 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

## **VII. ARGUMENT**

The Examiner has improperly rejected Appellant's claims under 35 U.S.C. §§ 101, 102(b) & 103(a). When the claims are reviewed under the current standards for statutory subject matter, anticipation, and obviousness as set by the Federal Circuit Court of Appeals and the Board of Patent Appeals and Interferences, the impropriety of the rejections becomes apparent.

### **i. Standard of Review**

#### **Patentable Subject Matter**

Under 35 U.S.C. § 101, “[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor....” *Id.* Laws of nature, physical phenomena, and abstract ideas are exceptions to the statutory subject matter categories provided in § 101. *Diamond v. Diehr*, 450 U.S. 175 (1981). However, an invention comprising a *Diamond v. Diehr* exception is patentable subject matter if it represents a practical application of the exception, and it does not preempt substantially all uses of the exception. *AT&T Corp. v. Excel Communications Inc.*, 172 F.3d 1352 (Fed. Cir. 1999).

#### **Anticipation**

Under 35 U.S.C. § 102(b), an invention is anticipated, and thus unpatentable, if the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States. “Rejection [of a claim] for anticipation

or lack of novelty requires, as the first step in the inquiry, that all the elements of the claimed invention be described in a single reference. Further, the reference must describe the Appellants' claimed invention sufficiently to have placed a person of ordinary skill in the field of the invention in possession of it." *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655 (Fed. Cir. 1990) (citations omitted).

### **Obviousness**

Obviousness is a question of law based on (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; (3) the level of ordinary skill in the art; and (4) objective evidence of nonobviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). "In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art." *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). "If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent." *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the

claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. M.P.E.P. (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)).

Teachings in a reference indicating that a proposed combination should not be made must be considered when determining whether there is a motivation to make the proposed combination. *In re Young*, 927 F.2d 588, 18 USPQ2d 1089 (Fed. Cir. 1991). For example, the proposed modification can not render the prior art unsatisfactory for its intended purpose. *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984). Moreover, the proposed modification can not change the principle of operation of a reference. *In re Ratti*, 270 F.2d 810 (CCPA 1959).

The law is "clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) (citations omitted).

## **ii. Discussion**

Appellant asserts that A) the rejection of claims 1-32 under 35 U.S.C. § 101; B) the rejection of claims 1, 4, 6-9, 12, 14, 15-17, 20, 22-25, 28, and 30-32 under 35 U.S.C. § 102(b) as being anticipated by Salgado is improper; C) the rejection of claims 2, 10, 18, and 26 under 35 U.S.C. § 103(a) as being unpatentable over Salgado in view of Kanerva et al. is improper; and D) the rejection of claims 3, 5 11, 13, 19, 21, 27, and 29



under 35 U.S.C. § 103(a) as being unpatentable over Salgado in view of Hicks et al. is improper.

**A. The Claims Recite Patentable Subject Matter Under 35 U.S.C. § 101**

The Examiner has not met his burden to establish a *prima facie* case that the rejected claims do not recite patentable subject matter under 35 U.S.C. § 101. Specifically, the assertion that the claims recite excepted subject matter from 35 U.S.C. § 101 without practical applications is in error. The assertion is in error at least because the claims recite more than merely abstract ideas without practical application. As the various claims recite different groups of subject matter, the specific grounds establishing that each group recites patentable subject matter are presented separately.

**i. *Claims 1-8***

Claim 1 recites a method including a series of acts, placing it squarely within the definition of a patentable “process” under 35 U.S.C. § 101. As recently as this Board’s decision in *Ex parte Nuijten*, a “process” was interpreted to be “a series of acts.” *Ex parte Nuijten*, 2006 Pat. App. LEXIS 50 (TTAB 2006). However, despite the series of acts recited in claim 1 itself, the Examiner looks to different claims to base his conclusion that “in reality” claim 1 does not recite a process, but instead seeks protection for an abstract idea of computer executable instructions.

The language recited in claim 1 itself is the proper basis for determining if claim 1 recites patentable subject matter, not the claim language recited in other claims. “Claims should be evaluated by their limitations, not by what they incidentally cover.” *In re Warmerdam*, 33 F.3d 1354 (Fed. Cir. 1994). It is improper to look to other claims to

read into a claim a desired scope of protection. A claim's express language defines the metes and bounds of protection afforded to it and, as such, the claim's language determines whether it satisfies the statutory requirements for patent protection.

Claim 1 recites a method, which falls under the "process" category of § 101. However, even if the Examiner's belief was correct that claim 1 does not in reality recite a method, but instead recites computer executable instructions, that would not change the fact that claim 1 recites patentable subject matter. "Without question, software code alone qualifies an invention eligible for patenting under [§ 101] categories, at least as processes." *Eolas Techs., Inc. v. Microsoft Corp.*, 399 F.3d 1325 (Fed. Cir. 2005). The Examiner points to guidelines in the MPEP describing computer related subject matter in terms of either "functional descriptive material" or "non-functional descriptive material," but such a classification scheme is not relevant when a claim does not recite a memory or storage medium. *Ex parte Nuijten*, 2006 Pat. App. LEXIS 50, 66 (TTAB 2006). Instead, the standard of review provided above for patentable subject matter under § 101 is believed to reflect the current standard for determining whether claim 1 recites patentable subject matter.

The claim 1 method recites more than merely an abstract idea. "[A]bstract ideas constitute disembodied concepts or truths which are not 'useful' from a practical standpoint standing alone, i.e., they are not 'useful' until reduced to some practical application." *In re Alappat*, 33 F.3d 1526, 1543 n.18 (Fed. Cir. 1994). For example, an invention is merely an abstract idea when it does nothing more than manipulate mathematical constructs or natural phenomena. *Warmerdam v. Verwer*, 33 F.3d 1354

(Fed. Cir. 1994). Thus, a method consisting primarily of refining a mathematical model is merely an abstract idea. *Id.* Further, the *Ex parte Nuijten* Board determined that a signal with embedded data is merely an abstract idea. *Ex parte Nuijten*.

However, claim 1 recites a method with specific and definite steps, such as adding files to a profile, specifying characteristics, and printing a presentation package, which demonstrates that it recites more than merely an abstract idea. The abstract idea embodied in claim 1 is organizing files into a package, but claim 1 recites objective steps beyond merely the disembodied concept of organizing files. Indeed, claim 1 recites definite actions, such as adding files to a profile, specifying characteristics, and printing a presentation package, which do more than apply a mathematical formula or make use of a natural phenomena. Thus, claim 1 recites more than merely an abstract idea.

Even if the Board concludes that claim 1 recites an abstract idea, it is patentable subject matter because it recites a practical application, namely printing a presentation package.

An invention represents a practical application of an exception if it produces a “useful, concrete, and tangible result.” *AT&T* at 1358-9. Transforming an article into a different state or thing and transforming data from one form to another form are useful, concrete, and tangible results. *Id.* For example, transforming data to produce a smooth waveform was a useful, concrete and tangible result. *State Street Bank & Trust v. Signature Fin. Ser.*, 149 F.3d 1368 (Fed. Cir. 1998) (citing *In re Alappat*, 33 F.3d 1526 (Fed Cir. 1994)). Similarly, transforming heartbeat signals into a representation of the

heart's condition was a useful, concrete, and tangible result. *State Street Bank* (citing *Arrhythmia Research Tech. Inc. v. Corazonix Corp.*, 958 F.2d 1053 (Fed. Cir. 1992). Likewise, transforming dollar amounts via mathematical calculations into a share price was a useful, concrete and tangible result. *Id.*

Claim 1 recites a practical application of printing a presentation package that includes each file in a profile and reflects different specified characteristics. Printing a presentation package is useful because it provides a user with a presentation package, which can be used to facilitate presentations or simply to review a plurality of files in a single package with specified characteristics. The method is concrete because the same presentation package can be substantially reproduced by the method when the same files are added and the same characteristics are specified. The method is tangible because it produces the real-world result of a printed presentation package. Thus, the method recites a practical application because it produces useful, concrete, and tangible results.

The Examiner asserts that claim 1 recites merely an abstract idea, but has not established that the claim would preempt all substantial uses of the abstract idea. Because claim 1 recites a practical application, it recites patentable subject matter unless it covers every substantial application of an abstract idea. The abstract idea of organizing files embodied in claim 1 is not preempted by the recited method because it is more specific than merely organizing files. The clear steps of adding files, specifying individual printing characteristics, specifying individual packaging characteristics, and

printing a presentation package leave numerous alternative methods of organizing files available.

For at least these reasons, claim 1 recites patentable subject matter under 35 U.S.C. § 101. Claims 2-8 depend from claim 1 and, accordingly, recite patentable subject matter for at least the reasons provided for claim 1.

**ii. Claims 9-16**

Claim 9 recites a computer-readable medium comprising computer executable instructions to print a plurality of files in a presentation. The Examiner asserts that the claim 9 fails to recite patentable subject matter because it recites: comprising computer-executable instructions instead of encoded with computer-executable instructions. Appellant is aware of no requirement that encoded be used instead of comprising in the controlling decisions of the Federal Circuit Court of Appeals or this Board. Instead, the Examiner points to page 53 of the interim guidelines for computer related inventions in the MPEP, which is not binding precedent. The interim guidelines state that a computer-readable medium encoded with a computer program would be patentable subject matter, but Appellant is not aware of any authority that suggests that using comprising somehow changes that result. The interim guidelines refer to *In re Lowry*, 32 F.3d 1579 (Fed. Cir. 1994), but that case does not even use the word “encode”. Because a computer-readable medium comprising computer executable instructions encompasses a computer-readable medium encoded with computer executable instructions, this distinction appears to be without merit.

The computer-executable instructions recited in claim 9 recite more than merely an abstract idea as evidenced by its specific steps of instructions to print a plurality of files in a presentation. An abstract idea embodied in the claim might be described as organizing files into a package. However, claim 9 recites adding files to a profile, specifying printing characteristics, specifying packaging characteristics, and printing a presentation package. Thus, the claim recites more than merely an abstract idea, but instead recites actual steps to carry out printing a presentation package.

Whether claim 9 recites an abstract idea is not dispositive to the patentable subject matter issue because claim 9 recites a practical application. Claim 9 recites printing a presentation package which is a useful, concrete, and tangible result of organizing files into a package. Presentation packages are useful for presenting files. The presentation package can be substantially reproduced each time the claim 9 instructions are executed, which renders the result concrete. Further, the instructions produce a real-world result of a printed presentation package, which makes the result tangible. Accordingly, claim 9 produces a practical application because the result of the computer-executable instructions is useful, concrete, and tangible.

Further, the claim 9 computer-executable instructions of the recited computer-readable medium would not preempt all substantial uses of organizing files. Many different methods of organizing files could be employed that would not be covered by the instructions for printing a plurality of files in a presentation. For example, one could simply print all files added to a presentation profile without printing them based on specified printing and packaging characteristics.

For at least these reasons, claim 9 and claims 10-16 depending from claim 9 recite patentable subject matter under 35 U.S.C. § 101.

**iii. Claims 17-24**

Claim 17 recites a computing device comprising a memory and a processor operatively coupled to the memory. The memory comprises computer-executable instructions for printing each file in a presentation profile. The processor is configured to fetch the instructions from memory and execute them.

A computing device is statutory subject matter and the inclusion of a memory comprising computer executable instructions does not change that fact. The very guidelines the Examiner cites states that, in the case where a “computer program is claimed as part of an otherwise statutory manufacture or machine...the claim remains statutory irrespective of the fact that a computer program is included in the claim.” MPEP § 2106.01. A computing device is a statutory machine under 35 U.S.C. 101 and its patentability depends on whether it is novel and nonobvious. *In re Alappat*, 33 F.3d 1526 (Fed. Cir. 1994). Thus, the claim 17 computing device is a statutory machine irrespective of the fact that it includes a memory comprising computer-executable instructions.

Because claims 17-24 recite computing devices with physical features, such as memories and processors, the claims recite statutory machines under 35 U.S.C. § 101. Thus, the claims recite patentable subject matter which makes the rejection under 35 U.S.C. § 101 improper.

**iv. Claims 25-32**

User interfaces are patentable subject matter under 35 U.S.C. § 101. One example of a prior granted U.S. Patents with claims directed to user interfaces is U.S. Patent No. 7,166,791 owned by Apple Computer, Inc. entitled GRAPHICAL USER INTERFACE AND METHODS OF USE THEREOF IN A MULTIMEDIA PLAYER. Similarly, another example of a granted user interface patent is U.S. Patent No. 6,928,433 owned by Creative Technology Ltd. entitled AUTOMATIC HIERARCHICAL CATEGORIZATION OF MUSIC BY METADATA. Both referenced patents claim user interfaces for the management of music files. User interfaces for managing music files are similar in many respects to the user interface recited in claim 25 directed to printing presentation package files. Accordingly, the user interface of claim 25 is statutory subject matter for similar reasons to those establishing that the user interfaces in the aforementioned granted patents to Apple Computer Inc. and Creative Technology Ltd. are statutory subject matter.

Expressly reciting that a user interface is operated on a computing device is not required when the specification makes clear that the user interface is intended for operation on a computing device. *In re Dossel*, 115 F.3d 942, 946-7 (Fed. Cir. 1997); *Ex parte Bowman*, 61 USPQ2d 1669 (TTAB 2001) (Dixon, concurring). It is well within the ordinary skill in the art to appreciate that a “user interface” including areas for adding files, specifying characteristics, and printing a presentation package is intended for operation on a computer. The *In re Drossel* Court relied on the inferred disclosure of a computer to conclude that the claim at issue satisfied 35 U.S.C. § 112 ¶ 2 without using



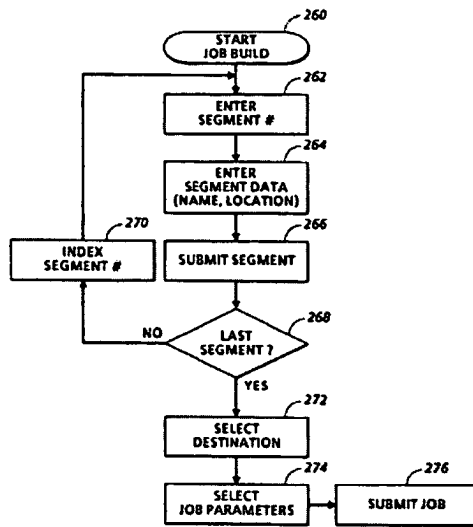
“the magic word ‘computer.’” *In re Drossel*, 115 F.3d at 947. In contrast, the application makes numerous references to the use of a computer. For example, Fig. 2 of the application is described on page 4 of the specification as showing “an exemplary user interface of a presentation print job profile **computer application window** to create and manage a presentation print job profile, as well as to print a presentation that is based on the presentation print job profile.” (emphasis added). Thus, the fact that claim 25 does not expressly recite that the user interface is operated on a computer is not dispositive to the 35 U.S.C. § 101 statutory subject matter issue at hand.

Claim 25 recites a specific and useful user interface for printing a presentation package including a plurality of added files and according to specified characteristics. Claim 25 is not attempting to claim the abstract idea of user interfaces in general, but rather recites a specific user interface that provides areas for creating and printing a presentation profile. Printing presentation profiles is useful for communicating ideas and the user interface recited in claim 25 is useful for facilitating the printing of presentation profiles by a user. Thus, claim 25 recites statutory subject matter because it recites a specific and useful user interface for printing presentation packages.

For at least these reasons, claim 25 and claims 26-32 depending from claim 25 recite statutory subject matter under 35 U.S.C. § 101.

**B. Salgado Fails to Disclose Each Feature Recited in the Claims**

The Examiner has failed to show that Salgado discloses each feature recited in claims 1, 4, 6-9, 12, 14, 15-17, 20, 22-25, 28, and 30-32, thus making the rejection of these claims under 35 U.S.C. § 102(b) improper.



Salgado Fig. 7

Salgado discloses a technique for constructing a print job from multiple segments using a network interface. As shown in the flow diagram above, the technique first involves creating a print job and then specifying parameters for that print job. Creating a complete print job involves initiating a print job editing program, indicating that a segment will be added to the print job by adding a new segment number to the print job, inputting the name and location of the segment to be included in the print job for the indicated segment number, saving the segment as part of the print job, and repeating that process until all segments have been added. Once all the segments have been added to the print job, parameters for a single, master print job are specified. The method of specifying print job parameters includes the steps of selecting a printer to print the print job, selecting paper size, number of print job copies, and whether the print job will be collated and stapled. After the print job parameters are specified, printing of the print job is initiated by submitting the print job.

**FIG. 5**

**FIG. 6**

As shown in Figs. 5 and 6 above, the steps of inputting segments into a print job and specifying print job parameters take place in two separate menus. In Fig. 5, a user can add segments to Print Job XXX by specifying a segment # in field 224 and entering segment data, such as its location using menu 206, a designated printer using menu 218, and file name using keypad 222. Once the user enters all segment info, he saves the segment to the print job by pressing button 226. When all segments have been saved to the print job, print job parameters are selected with the Fig. 6 menu. The Fig. 6 menu pertains to the print job as a whole (i.e., a single master print job) and not the individual segments in the print job, as indicated by the menu displaying only Print Job XXX in the heading. With the Fig. 6 menu, a user selects print job parameters, such as paper size from menu 230, collating and stapling from menu 234, and the number of copies of the print job to print at field 234.

**i. Claims 1, 4, 6-8**

Salgado does not disclose each feature recited in independent claim 1, or claims 4 and 6-8, depending from claim 1. Claim 1 is provided in full in the Appendix below, but generally recites a method comprising adding a plurality of files to a presentation

profile; specifying individual printing characteristics for each file; specifying individual packaging characteristics for each file, and printing the files in response to a single print request based on the specified individual printing and packaging characteristics.

Printing characteristics are distinct from packaging characteristics. In *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005), the Federal Circuit Court of Appeals declared that claims shall be construed by focusing primarily on how one skilled in the art would interpret the claims in light of the specification, rather than interpreting them in the abstract. *Id.* Applicant's specification describes packaging characteristics as whether the presentation package will be stapled or collated, which subset of files will be included in a general distribution package and which will be included in a different presentation package, and how many copies of the general distribution and presentation package will be printed. In contrast to packaging characteristics, the specification describes printing characteristics as which printer will be used and what media will be used. Thus, printing characteristics and packaging characteristics are properly interpreted as distinct features and as covering subject matter consistent with each of their descriptions in the specification.

Salgado does not disclose a method comprising the step of specifying a set of individual packaging characteristics with respect to each file added to a presentation profile. As shown in Fig. 6 above, Salgado specifies print job parameters for the entire print job. It does not specify parameters for each individual segment. As interpreted by the Examiner, a segment is analogous to a file, and parameters are analogous to packaging characteristics as recited in claim 1. Viewed through this frame of reference,

Salgado discloses specifying packaging characteristics for an entire presentation profile, but not specifying individual packaging characteristics for each file.

Contrary to the Examiner's assertion, Salgado does not disclose specifying individual packaging characteristics for each segment. In fact, the Examiner's proposed "packaging characteristics" would be inconsistent with the description of "packaging characteristics" throughout the specification. If anything, Salgado relates to specifying printing characteristics for each segment. Thus, Salgado does not disclose specifying individual packaging characteristics.

Because Salgado does not disclose specifying a set of individual packaging characteristics with respect to each of the files, it does not disclose each feature of claim 1. Accordingly, Salgado does not anticipate claim 1 under 35 U.S.C. § 102(b). Moreover, because claims 4 and 6-8 depend from claim 1, Salgado does not anticipate these claims either.

With particular regard to claim 4, Salgado does not disclose selecting packaging characteristic options comprising stapling and collating for a subset of files. Indeed, Salgado does not disclose specifying individual packaging characteristics for a subset of files, as discussed above. Rather, Salgado at step 274 selects from menu 232 in Fig. 6 whether the entire print job should be stapled or collated, not whether individual segments are stapled or collated.

**ii. Claims 9, 12, and 14-16**

Salgado does not disclose each feature recited in independent claim 9, or claims 12 and 14-16 depending from claim 9. Claim 9 is provided in full in the Appendix below,

but generally recites a computer-readable medium comprising computer-executable instructions to print a plurality of files in a presentation. The computer executable instructions comprise instructions for adding a plurality of files to a presentation profile; specifying individual printing characteristics for each file; specifying individual packaging characteristics for each file, and printing the files in response to a single print request based on the specified individual printing and packaging characteristics.

As noted above, printing characteristics are distinct from packaging characteristics. Applicant's specification describes packaging characteristics as whether the presentation package will be stapled or collated, which subset of files will be included in a general distribution package and which will be included in a different presentation package, and how many copies of the general distribution and presentation package will be printed. In contrast to packaging characteristics, the specification describes printing characteristics as which printer will be used and what media will be used. Thus, printing characteristics and packaging characteristics are properly interpreted as distinct features and as covering subject matter consistent with each of their descriptions in the specification.

Salgado does not disclose computer-executable instructions comprising instructions for specifying a set of individual packaging characteristics with respect to each file added to a presentation profile. As shown in Fig. 6 above, Salgado specifies print job parameters for the entire print job. As interpreted by the Examiner, a segment is analogous to a file, and parameters are analogous to packaging characteristics as recited in claim 9. Viewed through this frame of reference, Salgado discloses specifying

packaging characteristics for an entire presentation profile, but not specifying individual packaging characteristics for each file.

Because Salgado does not disclose specifying a set of individual packaging characteristics with respect to each of the files, it does not disclose each feature of claim 9. Accordingly, Salgado does not anticipate claim 9 under 35 U.S.C. § 102(b). Moreover, because claims 12 and 14-16 depend from claim 9, Salgado does not anticipate these claims either.

With particular regard to claim 9, Salgado does not disclose selecting packaging characteristic options comprising stapling and collating for a subset of files. Indeed, Salgado does not disclose specifying individual packaging characteristics for a subset of files, as discussed above. Rather, Salgado at step 274 selects from menu 232 in Fig. 6 whether the entire print job should be stapled or collated, not whether individual segments are stapled or collated.

**iii. Claims 17, 20, and 22-24**

Salgado does not disclose each feature recited in independent claim 17, or claims 20 and 22-24 depending from claim 17. Claim 17 is provided in full in the Appendix below, but generally recites a computing device comprising a memory with computer-executable instructions for automatically printing each file in a presentation profile; and a processor operatively coupled to the memory and configured to fetch and execute the computer-executable instructions from the memory. The computer executable instructions comprise instructions for adding a plurality of files to a presentation profile; specifying individual printing characteristics for each file; specifying

individual packaging characteristics for each file, and printing the files in response to a single print request based on the specified individual printing and packaging characteristics.

Applicant again notes that printing characteristics are distinct from packaging characteristics. Applicant's specification describes packaging characteristics as whether the presentation package will be stapled or collated, which subset of files will be included in a general distribution package and which will be included in a different presentation package, and how many copies of the general distribution and presentation package will be printed. In contrast to packaging characteristics, the specification describes printing characteristics as which printer will be used and what media will be used. Thus, printing characteristics and packaging characteristics are properly interpreted as distinct features and as covering subject matter consistent with each of their descriptions in the specification.

Salgado does not disclose computer-executable instructions comprising instructions for specifying a set of individual packaging characteristics with respect to each file added to a presentation profile. As shown in Fig. 6 above, Salgado specifies print job parameters for the entire print job. It does not specify parameters for each individual segment. Even assuming the Examiner's assertion that a segment is analogous to a file and parameters are analogous to packaging characteristics, Salgado only discloses specifying packaging characteristics for an entire presentation profile. Salgado does not disclose specifying individual packaging characteristics for each file.



Because Salgado does not disclose specifying a set of individual packaging characteristics with respect to each of the files, it does not disclose each feature of claim 17. Accordingly, Salgado does not anticipate claim 17 under 35 U.S.C. § 102(b). Moreover, because claims 20 and 22-24 depend from claim 17, Salgado does not anticipate these claims either.

With particular regard to claim 20, Salgado does not disclose selecting packaging characteristic options comprising stapling and collating for a subset of files. Indeed, Salgado does not disclose specifying individual packaging characteristics for a subset of files, as discussed above. Rather, Salgado at step 274 selects from menu 232 in Fig. 6 whether the entire print job should be stapled or collated, not whether individual segments are stapled or collated.

**iv. Claims 25, 28, and 30-32**

Salgado does not disclose each feature recited in independent claim 25 or claims 28 and 30-32 depending from claim 25. Claim 25 is provided in full in the Appendix below, but generally recites a user interface comprising a first area for adding a plurality of files to a presentation profile; a second area for specifying individual packaging characteristics for each file; a third area for indicating individual printing characteristics for each file, and printing the files in response to a single print request based on the specified individual printing and packaging characteristics.

Again, applicant asserts that printing characteristics are distinct from packaging characteristics. Applicant's specification describes packaging characteristics as whether the presentation package will be stapled or collated, which subset of files will be

included in a general distribution package and which will be included in a different presentation package, and how many copies of the general distribution and presentation package will be printed. In contrast to packaging characteristics, the specification describes printing characteristics as which printer will be used and what media will be used. Thus, printing characteristics and packaging characteristics are properly interpreted as distinct features and as covering subject matter consistent with each of their descriptions in the specification.

Salgado does not disclose a user interface comprising a second area for specifying a set of individual packaging characteristics with respect to each file added to a presentation profile. As shown in the Fig. 6 user interface above, Salgado provides an area to specify print job parameters for the entire print job. It does not provide an area to specify parameters for each individual segment. Indeed, the Fig. 6 user interface pertains only to Print Job XXX as specific segment fields are not present in the heading along side Print Job XXX field 202. According to the Examiner, a segment is analogous to a file and parameters are analogous to packaging characteristics as recited in claim 25. Viewed through this frame of reference, Salgado shows in Fig. 6 an area for specifying packaging characteristics for an entire presentation profile, but not an area for specifying individual packaging characteristics for each file.

Because Salgado does not disclose specifying a set of individual packaging characteristics with respect to each of the files, it does not disclose each feature of claim 25. Accordingly, Salgado does not anticipate claim 25 under 35 U.S.C. § 102(b).

Moreover, because claims 28 and 30-32 depend from claim 25, Salgado does not anticipate these claims either.

With particular regard to claim 28, Salgado does not disclose selecting packaging characteristic options comprising stapling and collating for a subset of files. Indeed, Salgado does not disclose specifying individual packaging characteristics for a subset of files, as discussed above. Rather, Salgado at step 274 selects from menu 232 in Fig. 6 whether the entire print job should be stapled or collated, not whether individual segments are stapled or collated.

**v. Salgado Does Not Anticipate the Claims Rejected by the Examiner**

For at least the reasons provided above, Salgado does not disclose each feature recited in claims 1, 4, 6-9, 12, 14, 15-17, 20, 22-25, 28, and 30-32. Accordingly, it does not anticipate the claims under 35 U.S.C. § 102(b). Therefore, the claim rejections under 35 U.S.C. § 102(b) are improper.

**C. Combining Salgado with Kanerva et al. Does Not Establish a *Prima Facie* Case that the Rejected Claims are Obvious**

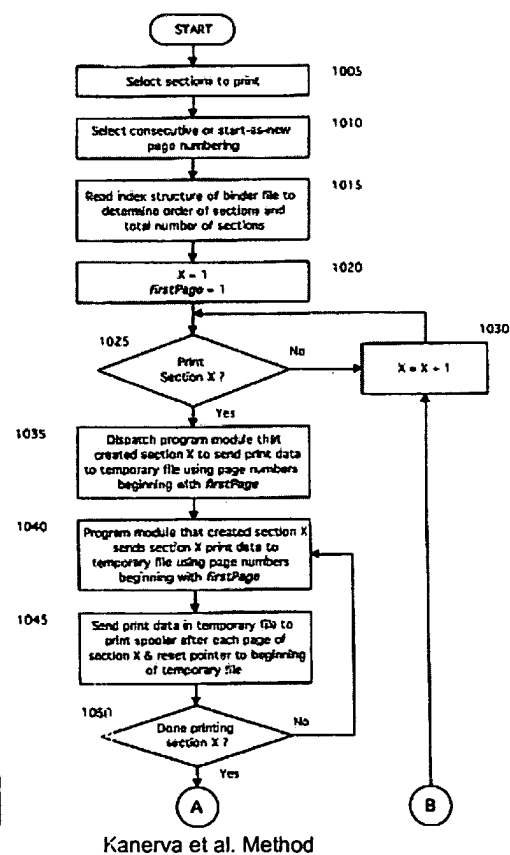
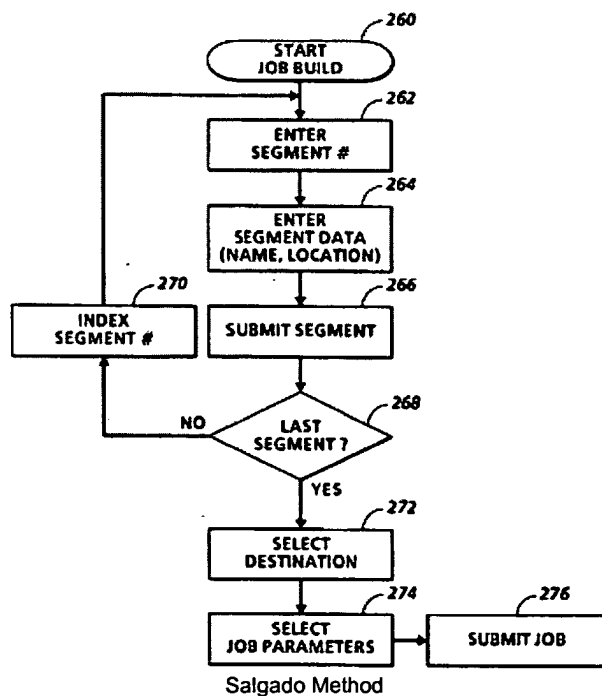
The Examiner has not made a *prime facie* case that claims 2, 10, 18, and 26 are obvious under 35 U.S.C. § 103(a) because one skilled in the art would not be motivated to combine Salgado with Kanerva et al. as proposed by the Examiner. One would not be motivated to make the combination because Kanerva et al. teaches away from Salgado and because the combination would change the Salgado principle of operation.

The Examiner admits that Salgado does not disclose indicating different subsets of files generated by different computer programs. While the Examiner asserts that Salgado discloses each feature of the underlying independent claims 1, 9, 17, and 25,

he relies on Kanerva et al. to disclose indicating different file subsets generated by different computer programs. However, absent a motivation to combine Salgado and Kanerva et al., a rejection based on such a combination under 35 U.S.C. § 103(a) would not be proper.

**i. Kanerva et al. Teaches Away from Salgado.**

One skilled in the art would not be motivated to combine Salgado with Kanerva et al. because Kanerva et al. teaches away from Salgado. As discussed above, Salgado provides a method for constructing a multi-segment print job from multiple sources using a network interface. Kanerva et al. provides a system and method for processing ordered binder document sections having different file formats.



Kanerva et al. teaches away from specifying printing and packaging characteristics for each file in a presentation profile. The Examiner interprets Salgado as disclosing a method including specifying a set of individual printing characteristics with respect to each file in a presentation profile. In contrast to the central control over printing characteristics described in Salgado, Kanerva et al. states that by “having the corresponding application program control the actual creation of print data rather than the binder program module, better control and quality of the printed section is attained.” (Col. 26, ln. 57). Kanerva et al. further highlights that decentralized control “can better control page breaks and other printing parameters that may be customized for [a] particular section.” (Col. 26, ln. 60). One seeking to develop the method recited in claim 1 would not be motivated to combine Salgado, teaching centralized control of printing characteristics, with Kanerva et al., teaching decentralized control.

**ii. The Examiner’s Proposed Modification of Salgado Changes its Principle of Operation.**

One skilled in the art would know that the proposed modification of Salgado with Kanerva et al. would change the Salgado principle of operation. As discussed above, the Examiner interprets Salgado as providing for specifying printing and packaging characteristics for each file in a presentation profile. However, the Kanerva et al. method involves sending commands to application program modules corresponding to each section of the print job to handle printing. Whereas Salgado specifies printing and packaging characteristics at a network interface, Kanerva et al. calls up different application programs to print with application-specific printing characteristics. Thus, combining Kanerva et al. with Salgado would modify Salgado’s principle of operation;

namely, changing its operating principle from one where printing and packaging characteristics are supplied by a user at a network interface to one where different application programs dictate such characteristics.

**iii. There is No Motivation to Combine Salgado and Kanerva et al. and the Claims are Not Prima Facie Obvious.**

Because combining Salgado with Kanerva et al. as proposed by the Examiner would modify the Salgado principle of operation, and because Kanerva et al. teaches away from Salgado, one skilled in the art would not be motivated to make the combination. Lacking a motivation to combine the references, the Examiner has failed to meet the burden of establishing a *prima facie* case that claims 2, 10, 18, and 26 are obvious under 35 U.S.C. § 103(a). Therefore, the rejection of claims 2, 10, 18, and 26 under 35 U.S.C. § 103(a) is improper.

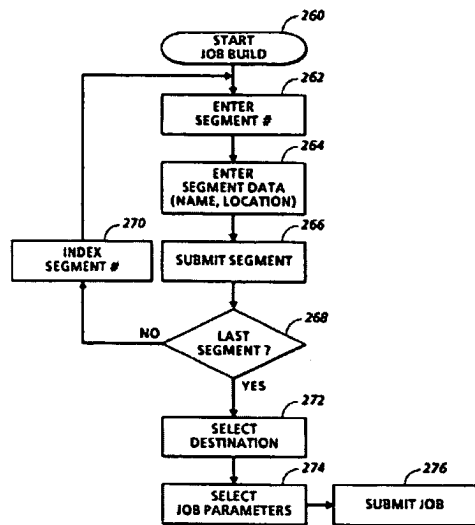
**D. Combining Salgado with Hicks et al. Does Not Establish a Prima Facie Case that the Rejected Claims are Obvious**

The Examiner has not met his burden of establishing that claims 3, 5 11, 13, 19, 21, 27, and 29 are *prima facie* obvious under 35 U.S.C. § 103(a). The Examiner has not met his burden because combining Salgado and Hicks et al. does not disclose each feature recited in the claims and one skilled in the art would not be motivated to combine the references.

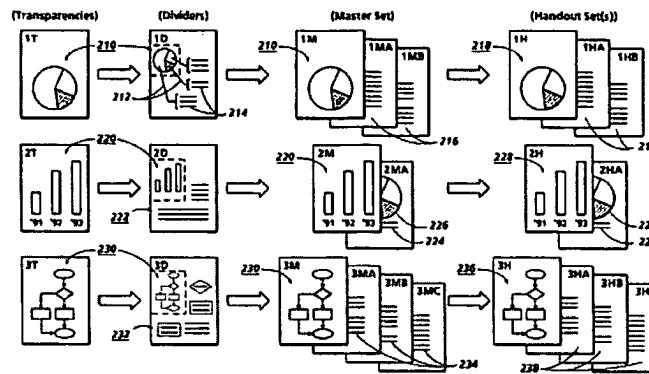
**i. Combining Salgado and Hicks et al. does not Disclose Each Feature Recited in the Rejected Claims.**

The Examiner asserts that Salgado discloses each feature of independent claims 1, 9, 17, and 25, but that it does not disclose features recited in dependant claims 3, 5, 11, 13, 19, 21, 27, and 29. Namely, the Examiner admits that Salgado does not disclose identifying a first subset of presentation package files and a different, second subset of general distribution files as recited in dependant claims 3, 11, 19, and 27. Further, the Examiner admits that Salgado does not disclose indicating the number of copies to print of the first subset of files to be included in the presentation package as recited in dependant claims 5, 13, 21, and 29. Thus, the Examiner relies on Hicks et al. to provide the disclosures missing from Salgado.

Hicks et al. provides an apparatus for producing variable feature presentation sets. The Hicks et al. apparatus is adapted to input an original document, whether in electronic or hardcopy form, and output at least a portion of the original document on various forms of media. For example, Hicks et al. states that the original document can be printed onto transparencies, divider sheets, master sets, or handout sets. The order of output also can be specified. For example, the divider sheet output can be sequenced such that each transparency is separated by a divider sheet. The source image applied to each type of output media is the same; namely, the original document is applied to each output media type or portions of the original document are applied to each output media type.



Salgado Method



Hicks et al. Method

Salgado combined with Hicks et al. does not disclose the step of identifying a first subset of presentation package files and a different, second subset of general distribution files as recited in dependant claims 3, 11, 19, and 27. The Examiner admits that Salgado does not disclose this feature, but relies on Hicks et al. for its disclosure. However, Hicks et al. does not disclose multiple files and therefore can not disclose indicating a subset of files to be included in a general distribution package.

Instead of disclosing multiple files, Hicks et al. makes repeated references to a single source document. For example, Hicks et al. states that “a hard copy or electronic document is used to generate transparencies, dividers, an/or handouts. . . .” (Col. 9, In 13) (emphasis added). Further, Hicks et al. states that “the master document set may in some embodiments be used as the document upon which the other (edited) documents are based.” (Col. 9, In 15)(emphasis added). The consistent references to a single source document, which is outputted in whole or in part on different types of media, coupled with no references to the use of multiple files indicates that Hicks et al. does not



disclose multiple files. Accordingly, Hicks can not disclose indicating a subset of files as recited in the rejected claims.

Salgado combined with Hicks et al. does not disclose the step of indicating the number of copies to print the first subset of files to be included in the presentation package as recited in dependant claims 5, 13, 21, and 29. The Examiner admits that Salgado does not disclose this feature, but relies on Hicks et al. for its disclosure. However, as discussed above, Hicks et al. does not disclose multiple files; thus, Hicks et al. can not disclose indicating how many copies of a subset of files to print. Instead, Hicks et al. discloses printing multiple copies of an original document or multiple copies of a portion of that original document. Because Hicks et al. pertains to an apparatus for printing a single document instead of multiple files, it does not disclose the step of indicating how many copies of a subset of files are to be printed.

**ii. No Motivation to Make the Examiner's Proposed Combination**

One skilled in the art would not be motivated to combine Salgado with Hicks et al. because such a combination would alter the Salgado principle of operation and would not prove fruitful in solving the problem solved in the rejected claims. The Hicks et al. apparatus operates by inputting a single original document and specifying what type of media, e.g. transparencies or opaque sheets, on which the original document will be printed. The Salgado method, on the other hand, works with multiple files to construct a print job.

Modifying Salgado to input a single original document as taught in Hicks et al., instead of inputting multiple files, would change its principle of operation. Salgado states that an object of its invention is "to provide a technique to initiate selection of multiple remote electronic documents for combination . . . at a printing station for reproduction in a common document." (Col. 2, ln. 36). In contrast, Hicks et al. operates by inputting only a single document. Working with a single document is an entirely different method of printing presentation materials because no combination of files is required. In fact, the ability to combine files into a common print job is a salient feature of Salgado.

One would not be motivated to combine Hicks et al., a single input source reference, with Salgado, a multiple input source reference, to derive the solution of identifying different subsets of files. One desiring to treat different subsets of files in a presentation package differently would not be motivated to look to a reference like Hicks et al. pertaining to only a single file, the original document. To the contrary, to solve this problem a reference pertaining to multiple files is required. The Examiner has admitted that Salgado alone does not disclose identifying different subsets of files. Thus, one must look elsewhere to solve the problem solved by the rejected claims. In fact, one must look to Applicant's application for the first instance that these solutions were disclosed.

## **VIII. CLAIMS APPENDIX**

1. A method comprising:  
  
adding a plurality of files to a presentation profile;  
  
specifying a set of individual printing characteristics with respect to each of the files;  
  
specifying a set of individual packaging characteristics with respect to each of the files; and  
  
responsive to a single print request, printing a presentation package including each of the files in the presentation profile based on the individual packaging characteristics and individual printing characteristics corresponding to each of the files.
2. A method as recited in claim 1, wherein a first subset of the files were generated using a first computer program application, and wherein a second subset of the files were generated using a second computer program application that is different than the first computer program application.
3. A method as recited in claim 1, wherein specifying the packaging characteristics further comprises:  
  
identifying a first subset of the files that are to be included in the presentation package and a second subset of the files that are to be included in a general distribution package, wherein the second subset of files is different than the first subset of files.

**iii. Thus, the Examiner's Proposed Combination Does Not Establish that the Rejected Claims are *Prima Facie* Obvious.**

Because combining Salgado and Hicks et al. does not disclose each feature recited in claims 3, 5 11, 13, 19, 21, 27, and 29 and because one skilled in the art would not be motivated to make the combination, the Examiner has not met his burden to establish that the rejected claims are *prima facie* obvious. Since a *prima facie* case that the claims are obvious is required to find the claims unpatentable under 35 U.S.C. § 103(a), the rejections are improper.

4. A method as recited in claim 1, wherein specifying the packaging characteristics further comprises:

selecting one or more options to identify how at least one subset of the files of the presentation package are packaged, the one or more options comprising stapling the at least one subset of files together and collating the at least one subset of files.

5. A method as recited in claim 1, wherein specifying the packaging characteristics further comprises:

identifying a subset of files that are to be included in a general distribution package; and

indicating a number of copies to print with respect to the subset of the files that are to be included in the general distribution package.

6. A method as recited in claim 1, wherein specifying the packaging characteristics further comprises:

indicating a number of copies to print with respect to a subset of the files that are to be included in the presentation package.

7. A method as recited in claim 1, wherein specifying the printing characteristics further comprises:

identifying a specific printer to print each of the files.

8. A method as recited in claim 1, wherein specifying the printing characteristics further comprises:

indicating which of a plurality of print media supply bins are to be used by a printer to print individual ones of the files.

9. A computer-readable medium comprising computer-executable instructions to print a plurality of files in a presentation, the computer-executable instructions comprising instructions for:

adding a plurality of files to a presentation profile;

specifying a set of individual printing characteristics with respect to each of the files;

specifying a set of individual packaging characteristics with respect to each of the files; and

responsive to a single print request, printing a presentation package including each of the files in the presentation profile based on the individual packaging characteristics and individual printing characteristics corresponding to each of the files.

10. A computer-readable medium as recited in claim 9, wherein a first subset of the files were generated using a first computer program application, and wherein a second subset of the files were generated using a second computer program application that is different than the first computer program application.

11. A computer-readable medium as recited in claim 9, wherein the instructions for specifying the packaging characteristics further comprising instructions for:

identifying a first subset of the files that are to be included in the presentation package and a second subset of the files that are to be included in a general distribution package, wherein the second subset of files is different than the first subset of files.

12. A computer-readable medium as recited in claim 9, wherein the instructions for specifying the packaging characteristics further comprising instructions for:

selecting one or more options to identify how at least one subset of the files of the presentation package are packaged, the one or more options comprising stapling the at least one subset of files together and collating the at least one subset of files.

13. A computer-readable medium as recited in claim 9, wherein the instructions for specifying the packaging characteristics further comprising instructions for:

identifying a subset of files that are to be included in a general distribution package; and

indicating a number of copies to print with respect to the subset of the files that are to be included in the general distribution package.

14. A computer-readable medium as recited in claim 9, wherein the instructions for specifying the packaging characteristics further comprising instructions for:

indicating a number of copies to print with respect to at least a first subset of the files that are independent of at least a second subset of the files that are to be included in the presentation package.

15. A computer-readable medium as recited in claim 9, wherein the instructions for specifying the printing characteristics further comprising instructions for:  
identifying a specific printer to print each of the files.

16. A computer-readable medium as recited in claim 9, wherein the instructions for specifying the printing characteristics further comprising instructions for:  
indicating which of a plurality of print media supply bins are to be used by a printer to print individual ones of the files.

17. A computing device comprising:  
a memory comprising computer-executable instructions for automatically printing each file in a presentation profile;

a processor that is operatively coupled to the memory, the processor being configured to fetch and execute the computer-executable instructions from the memory, the computer-executable instructions comprising instructions for:

adding a plurality of files to a presentation profile;

specifying a set of individual printing characteristics with respect to each of the files;

specifying a set of individual packaging characteristics with respect to each of the files; and

responsive to a single print request, printing a presentation package including each of the files in the presentation profile based on the individual packaging characteristics and individual printing characteristics corresponding to each of the files.



18. A computing device as recited in claim 17, wherein a first subset of the files were generated using a first computer program application, and wherein a second subset of the files were generated using a second computer program application that is different than the first computer program application.

19. A computing device as recited in claim 17, wherein the instructions for specifying the packaging characteristics further comprising instructions for:

identifying a first subset of the files that are to be included in the presentation package and a second subset of the files that are to be included in a general distribution package, wherein the second subset of files is different than the first subset of files.

20. A computing device as recited in claim 17, wherein the instructions for specifying the packaging characteristics further comprising instructions for:

selecting one or more options to identify how at least one subset of the files of the presentation package are packaged, the one or more options comprising stapling the at least one subset of files together and collating the at least one subset of files.

21. A computing device as recited in claim 17, wherein the instructions for specifying the packaging characteristics further comprising instructions for:

identifying a subset of files that are to be included in a general distribution package; and

indicating a number of copies to print with respect to the subset of the files that are to be included in the general distribution package.

22. A computing device as recited in claim 17, wherein the instructions for specifying the packaging characteristics further comprising instructions for:

indicating a number of copies to print with respect to at least a first subset of the files that are independent of at least a second subset of the files that are to be included in the presentation package.

23. A computing device as recited in claim 17, wherein the instructions for specifying the printing characteristics further comprising instructions for:

identifying a specific printer to print each of the files.

24. A computing device as recited in claim 17, wherein the instructions for specifying the printing characteristics further comprising instructions for:

indicating which of a plurality of print media supply bins are to be used by a printer to print individual ones of the files.

25. A user interface comprising:

a first area for adding a plurality of files to a presentation profile;

a second area for specifying a set of individual packaging characteristics with respect to individual each of the files;

a third area for indicating a set of individual printing characteristics with respect to individual each of the files; and

a fourth area for printing a presentation package including each of the files in the presentation profile in response to a single print request, the printing being based on the individual packaging characteristics and individual printing characteristics corresponding to each of the files.

26. A user interface as recited in claim 25, wherein a first subset of the files are generated using a first computer program application, and wherein a second subset of the files are generated using a second computer program application that is different than the first computer program application.

27. A user interface as recited in claim 25, wherein the second area for specifying the packaging characteristics further comprises:

a fifth area for identifying a first subset of the files that are to be included in the presentation package and a second subset of the files that are to be included in a general distribution package, wherein the second subset of files is different than the first subset of files.

28. A user interface as recited in claim 25, wherein the second area for specifying the packaging characteristics further comprises:

a fifth area for selecting one or more options to identify how at least one subset of the files of the presentation package are packaged, the one or more options comprising stapling the at least one subset of files together and collating the at least one subset of files.

29. A user interface as recited in claim 25, wherein the second area for specifying the packaging characteristics further comprises:

a fifth area for identifying a subset of files that are to be included in a general distribution package and indicating a number of copies to print with respect to the subset of the files that are to be included in the general distribution package.

30. A user interface as recited in claim 25, wherein the second area for specifying the packaging characteristics further comprises:

a fifth area for indicating a number of copies to print with respect to at least a first subset of the files that are to be included in the presentation package.

31. A user interface as recited in claim 25, wherein the third area for specifying the printing characteristics further comprises:

a fifth area for identifying a specific printer to print each of the files.

32. A user interface as recited in claim 25, wherein the third area for specifying the printing characteristics further comprises:

a fifth area for indicating which of a plurality of print media supply bins are to be used by a printer to print individual ones of the files.

**IX. EVIDENCE APPENDIX**

None.

**X. RELATED PROCEEDINGS APPENDIX**

None.

Respectfully submitted,

KOLISCH HARTWELL, P.C.



---

Walter W. Karnstein  
Registration No. 35,565  
520 S.W. Yamhill Street, Suite 200  
Portland, Oregon 97204  
Telephone: (503) 224-6655  
Facsimile: (503) 295-6679  
Attorney for Appellant

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on June 22, 2007.



---

Christie A. Doolittle